UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,218	04/12/2004	C. Douglass Thomas	IPVMAP01	1308

34071 7590 10/15/2009

IPVENTURE, INC.
5150 EL CAMINO REAL
SUITE A-22
LOS ALTOS, CA 94022

EXAMINER	
VUONG, QUOCHIEN B	

ART UNIT	PAPER NUMBER
2618	

MAIL DATE	DELIVERY MODE
10/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/822,218	THOMAS ET AL.	
	Examiner	Art Unit	
	Quochien B. Vuong	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-28 and 32-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-28 and 32-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/22/09 and 06/24/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to applicant's response filed on 06/18/2009. Claims 26-28 and 32-53 are now pending in the present application. **This action is made final**.

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 06/22/2009 and 06/24/2009 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 39-44 and 47-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. (US 6,929,365) in view of Horiguchi (US 7,031,667) and further in view of Spitzer (US 6,091,546).

Regarding claim 39, Swab et al. (figures 1, 2a, and 3) disclose a method for operating a pair of eyeglasses having wireless communication circuitry (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising an indicator, the eyeglasses further operatively coupling to at least one sensor, the method comprising monitoring the wireless communication circuitry to determine an operational condition of the wireless communication circuitry, the operational condition indicating at least whether the wireless communication circuitry is in use; receiving sensor information from the at least one sensor; and controlling the indicator based on the operational condition of the wireless communication circuitry as determined by said monitoring and/or based on the sensor information as obtained by said receiving. However, Horiguchi disclose a wireless communication device (figure 2, portable telephone) comprising at least one operation indicator (light source) is controlled based on a monitored operational condition of the wireless communication circuitry and for indicating whether the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to one

ordinary skill in the art at the time the invention was made to adapt the at least one operation indicator of Horiguchi to the eyeglasses of Swab et al. to provide a visual indication of the operating state of the communication circuitry of the eyeglasses to the user. Swab et al. and Horiguchi do not specifically disclose the eyeglasses further coupling to at least one sensor and step of receiving sensor information from the at least one sensor. However, Spitzer discloses an eyeglasses interface system comprising a position sensor provided within the internal area of at least one of the arms (column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Spitzer to the eyeglasses of Swab et al. and Horiguchi in order to provide the location information to the user.

Regarding claim 40, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, Horiguchi discloses wherein the operational condition indicates at least that the wireless communication circuitry Is operating on an incoming call (see abstract; column 3, lines 28-45; and column 5, lines 16-58).

Regarding claim 41, Horiguchi discloses wherein the indicator comprises a light source (figure 2, lamp 1; column 5, lines 31-58).

Regarding claims 42 and 43, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, Spitzer discloses wherein the at least one sensor is internal or attached to the eyeglasses (column 11, lines 24-41).

Regarding claim 44, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, it would have been obvious for sensor of the eyeglasses of Swab, Horiguchi, and Spitzer being physically separate from the eyeglasses, and wherein the

sensor information from the sensor is wirelessly supplied to the eyeglasses as one of ordinary skill in the art to select as a system design preference serving the same function as providing sensor information to the user.

Regarding claims 47 and 48, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, Spitzer discloses wherein the sensor information from the at least one sensor is for a position of the eyeglasses and/or a position of a user of the eyeglasses (column 11, lines 11-23).

Regarding claims 49 and 50, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, Spitzer discloses wherein the wireless communication circuitry, the indicator and the at least one sensor are each partially internal to the eyeglasses; or wherein the eyeglasses interact with a base unit, and wherein the at least one sensor is operatively connected to the base unit (column 11, lines 24-41).

Regarding claims 51 and 52, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, Horiguchi disclose wherein the indicator comprises a visual indicator (figure 2, lamp 1) configure to controllably provide at least one or more visual indications. And it would have been obvious for the indicator of Swab, Horiguchi, and Spitzer to comprise an audio indicator as an alternate indicator for providing the same function as to notify the user of the operation condition of the wireless communication circuitry.

Regarding claim 53, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. In addition, Swab disclose wherein the eyeglasses are configured to operate with at least one speaker, and wherein the at least one speaker produces audio output

for the wireless communication circuitry (figures 3 and 4; column 5, line 66 – column 6, lines 51).

5. Claims 26-28, 32-38, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. (US 6,929,365) in view of Horiguchi (US 7,031,667) and Spitzer (US 6,091,546) and further in view of Himberg et al. (US 6,912,386).

Regarding claim 27 and 35, Swab et al. (figures 1, 2a, and 3) disclose a method for operating a pair of eyeglasses having wireless communication circuitry (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising an indicator, the eyeglasses further operatively coupling to at least one sensor, the method comprising monitoring the wireless communication circuitry to determine an operational condition of the wireless communication circuitry, the operational condition indicating at least whether the wireless communication circuitry is in use; receiving sensor information from the at least one sensor; and controlling the indicator based on the operational condition of the wireless communication circuitry as determined by said monitoring and/or based on the sensor information as obtained by said receiving. However, Horiguchi disclose a wireless communication device (figure 2, portable telephone) comprising at least one operation indicator (light source) is controlled based on a monitored operational condition of the wireless communication circuitry and for indicating whether the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to one

ordinary skill in the art at the time the invention was made to adapt the at least one operation indicator of Horiguchi to the eyeglasses of Swab et al. to provide a visual indication of the operating state of the communication circuitry of the eyeglasses to the user. Swab et al. and Horiguchi do not specifically disclose the eyeglasses further coupling to at least one sensor and step of receiving sensor information from the at least one sensor. However, Spitzer discloses an eyeglasses interface system comprising a position sensor provided within the internal area of at least one of the arms (column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Spitzer to the eyeglasses of Swab et al. and Horiguchi in order to provide the location information to the user. Swab, Horiguchi, and Spitzer do not disclose wherein the sensor information from the at least one sensor pertains to a physical condition or moot of a user of the eyeglasses. However, Himberg et al. disclose a mobile communication device with one or more sensors for providing a physical condition or moot of a user (column 2, lines 26-44). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the sensor and sensor information of Himberg et al. to the method of Swab, Horiguchi, and Spitzer in order to monitor the condition or action of the user as suggested by Himberg et al. (column 2, lines 32-32-34).

Regarding claim 26, Swab, Horiguchi, Spitzer, and Himberg et al. disclose the method of claim 27 above. In addition, Horiguchi discloses wherein the operational condition indicates at least that the wireless communication circuitry is operating on an incoming call (see abstract; column 3, lines 28-45; and column 5, lines 16-58).

Regarding claim 28, Horiguchi discloses wherein the indicator comprises a light source (figure 2, lamp 1; column 5, lines 31-58).

Regarding claims 32, 33, 36 and 37, Swab, Horiguchi, Spitzer, and Himberg et al. disclose the method of claims 27 and 35 above. In addition, Spitzer discloses wherein the at least one sensor is internal or attached to the eyeglasses (column 11, lines 24-41).

Regarding claims 34 and 38, Swab, Horiguchi, Spitzer, and Himberg et al. disclose the method of claims 27 and 35 above. In addition, it would have been obvious for sensor of the eyeglasses of Swab, Horiguchi, Spitzer and Himberg et al. being physically separate from the eyeglasses, and wherein the sensor information from the sensor is wirelessly supplied to the eyeglasses as one of ordinary skill in the art to select as a system design preference serving the same function as providing sensor information to the user.

Regarding claims 44 and 45, Swab, Horiguchi, and Spitzer disclose the method of claim 39 above. Swab, Horiguchi, and Spitzer do not disclose wherein the sensor information from the at least one sensor pertains to an emotional or physical condition of a user of the eyeglasses. However, Himberg et al. disclose a mobile communication device with one or more sensors for providing an emotional or physical condition of a user (column 2, lines 26-44). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the sensor and sensor information of Himberg et al. to the method of Swab, Horiguchi, and Spitzer in

order to monitor the condition or action of the user as suggested by Himberg et al. (column 2, lines 32-32-34).

Response to Arguments

6. Applicant's arguments filed 06/18/2009 have been fully considered but they are not persuasive.

Regarding claims 27, 35 and 39, Applicant argues that Swab et al. in view of Horiguchi fail to disclose "controlling the operation indicator based on the operational condition of the wireless communication circuitry, wherein the operation indicator indicates at least whether the wireless communication circuitry is in use". The examiner, however, does not agree with the Applicant. Applicant's attention is directed to Horiguchi (see abstract; column 3, lines 28-45; and column 5, line 16-58) which discloses an operation indicator (lamp 1) is controlled based on the operational condition of the wireless communication circuitry and illuminates when the portable phone is functioning in a noncommunicative mode and not illuminate when the portable phone is functioning in a communicating mode (i.e., in-use). Since the claims do not recite whether the operation indicator is on when the wireless communication circuitry is in use; therefore, Horiguchi's reference reads on the claimed limitation. And even if the claims recite that feature, it would have been obvious to alternate the illumination of the lamp of Horiguchi as the matter of design choice or preference.

Further more, in response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to adapt only the mode indicating lamp of Horguchi to the eyeglasses of Swab et al. for indicating whether the wireless communication circuitry is in used or not.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Quochien B Vuong/
Primary Examiner, Art Unit 2618